Applicant   : Clauss et al.   Attorney's Docket No.: 15786-005002
Serial No. : 10/081,446
Filed   : February 20, 2002
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REMARKS

Claims 16-67 are pending in this application. Claims 46-50, 52-56 and 58-62 are
rejected under 35 U.S.C. 101 as claiming the same invention as U.S. Patent No. 6,363,503.
Claims 16-25 are rejected under 35 U.S.C. 112, second paragraph. Claims 16-23, 26-33 and 36-
43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,397,117
("Burrows") in view of U.S. Patent No. 5,740,354 ("Ben-Natan"). Claims 24, 25, 34, 35, 44 and
45 are rejected under § 103(a) as being unpatentable over Burrows in view of Ben-Natan and
U.S. Patent No. 6,115,544 ("Mueller"). Claims 51, 57 and 63 are objected to as being
dependent upon a rejected base claim, but would be allowable if rewritten in an independent
form. Claims 64-67 are allowed. Claims 16, 26 and 36 have been amended. The applicant
respectfully traverses the rejections and requests reconsideration in view of the amendments and
following remarks.

I.   Double Patenting Rejections

Claims 46-50, 52-56 and 58-62 are rejected under 35 U.S.C. § 101 as claiming the same
invention as that of claims 1-5, 6-10 and 11-15, respectively, of U.S. Patent No. 6,363,503 (the
"'503 patent"); this is a double patenting rejection.

The applicant indicated, when adding these as new claims in the previous response to
office action, that these claims reflect a different scope of coverage than may be afforded to
claims 1-15 of the issued parent patent, which is the '503 patent, in view of a recent Federal
Circuit decision in SuperGuide Corp. v. DirectTv Enters., Inc., 358 F.3d 870; 69 U.S.P.Q.2D
(BNA) 1865. That case dealt with the construction of claims using the "at least one of A and B"
versus "at least one of A or B" language. Based on the Federal Circuit's decision, a claim
reading "at least one of A and B" may be interpreted to mean that an infringing device requires
at least one of A and at least one of B. By contrast, a claim reading "at least one of A or B" may
be interpreted to mean that an infringing device requires at least one of either A or B, but does
not require at least one of both A and B. As such, the scope of claim coverage can be different
when given the above different interpretations.

Claim 46 in the present application reads as follows:

A method comprising:

recognizing an occurrence of one or more software events that result in at least one of an error **or** a warning;

storing an indication of the error or warning in an error/warning storage structure; and

returning a result from a function call that indicates that the error/warning indication has been stored in the error/warning storage structure, wherein subsequent function call returns are not required to store error/warning indications resulting from the event causing the stored indication. [emphasis added]

By contrast, claim 1 in the '503 patent reads as follows:

A method comprising:

recognizing an occurrence of one or more software events that result in at least one of an error **and** a warning;

storing an indication of the error/warning in an error/warning storage structure; and

returning a result from a function call that indicates that the error/warning indication has been stored in the error/warning storage structure, wherein subsequent function call returns are not required to store error/warning indications resulting from the event causing the stored indication. [emphasis added]

The '503 patent uses the "at least one of A and B" language, whereas claim 46 in the present application uses the "at least one of A or B" language. Based on the recent Federal Circuit decision in SuperGuide the claims can be construed differently to have a different scope of coverage. Accordingly, they are not the same invention and should not be rejected on the basis of double patenting. The same arguments apply to the balance of the claims rejected on the basis of double patenting, claims 47-50, 52-56 and 58-62, in

that any "at least one of A and B" language has been changed to "at least one of A or B"
in the present claims.

Accordingly, in view of the above, the applicant respectfully submits that the
claims are in condition for allowance.

II.   § 112 Rejections

Claims 16-25 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite
for failing to particularly point out and distinctly claim the subject matter which the applicant
regards as the invention. Claim 16 has been amended in response to the § 112 rejection, and is
now in condition for allowance, as are dependent claims 17-25.

III.   § 103(a) Rejections

Claims 16-23, 26-33 and 36-43 are rejected under 35 U.S.C. § 103(a) as being
unpatentable over Burrows in view of Ben-Natan.

<u>Claims 16-23</u>

Claim 16 recites, in a computer apparatus executing a CAD application, a method
including the step of receiving a user input to perform an operation on a CAD design. A failure
is detected during performance of the operation, and a failure indication is generated upon
detecting the failure. A user is provided with information to facilitate the user in determining a
location of a cause of the failure within the CAD design and information about how to recover
from the failure.

Burrows is directed to a distributed CAD system that includes a CAD server station and
one or more CAD client stations connected to the CAD server station, for example, by an
intranet or the Internet. The CAD server station includes a CAD tool for performing CAD tasks
and the CAD client stations include display and data entry facilities for displaying a design
parameter entry document to a user and accepting design parameters entered by the user. The
Examiner asserts that Burrows discloses receiving user input to perform an operation on a CAD
design and generating a failure indication (error message) upon detecting a failure during
performance of the operation. The Examiner refers to Burrows at Figure 3, the abstract, col. 1
lines 11-14 and col. 4 lines 50-61. Burrows discloses nothing about generating a failure

indication, which is acknowledged by the Examiner. Burrows simply states at col. 1, line 14, that a CAD tool can process and display results and error messages and so on. The Examiner relies on Ben-Natan for disclosing a method of error handling, which the Examiner asserts discloses returning an error message as a result of a failure, which error message includes information to facilitate a user in determining a location of a cause of the failure and information about how to recover from the failure.

Ben-Natan is directed to a method for associating error reports. Ben-Natan does not teach or suggest a CAD application nor a CAD design, and does not disclose receiving user input to perform an operation on a CAD design, nor detecting a failure during performance of such an operation, as required by claim 16. Further, Ben-Natan fails to provide information to a user about how to recover from the failure. Merely providing an error report that indicates the presence of an error to a user does not provide information about how to recover from the failure; Ben Natan's user must recover from the failure without the benefit of information about how to recover. By contrast, information provided to a user about how to recover from a failure in one example can be the provision of a text string indicating "modeling error: shell too thick", if a construction error caused by a shell that is too thick is the cause of the failure [see Specification at p. 13, lines 3-13]. The user is thereby provided information about how to recover, *i.e.*, by making the shell thinner. Optionally, the "shell" portion of the CAD design can be highlighted to provide the user visual feedback related to the cause of the error/warning [see Specification at p. 13, lines 14-17].

Thus, neither Burrows nor Ben-Natan, alone or in combination, disclose the limitations of claim 16, and accordingly claim 16 is in condition for allowance. Claims 17-23 depend from claim 16, and are therefore allowable for at least the same reasons.

Claims 26-33

Claim 26 recites an apparatus including a storage medium having stored therein a plurality of programming instructions. When executed, the instructions cause the apparatus to: receive a user input to perform an operation on a CAD design; detect a failure during performance of the operation; generate a failure indication upon detecting the failure; and

provide a user with information to facilitate the user in determining a location of a cause of the failure within the CAD design and about how to recover from the failure.

For at least the reasons stated above in reference to claim 16, Burrows and Ben-Natan, alone or in combination, fail to disclose an apparatus having stored therein a plurality of programming instructions to cause an apparatus to perform the steps required by claim 26. In particular, they fail to disclose providing a user with information to facilitate the user in determining a location of a cause of a failure within the CAD design and about how to recover from the failure. Accordingly claim 26 is patentable over Burrows in view of Ben-Natan and is in condition for allowance. Claims 27-33 depend from claim 26 and are therefore allowable for at least the same reasons.

Claims 36-45

Claim 36 recites an article of manufacture having stored therein a plurality of programming instructions. When executed, the instructions cause a machine to: receive a user input to perform an operation on a CAD design; detect a failure during performance of the operation; generate a failure indication upon detecting the failure; and provide a user with information to facilitate the user in determining a location of a cause of the failure within the CAD design and about how to recover from the failure.

For at least the reasons stated above in reference to claim 16, Burrows and Ben-Natan, either alone or in combination, fail to disclose an apparatus having stored therein a plurality of programming instructions to cause an apparatus to perform the steps required by claim 36. In particular, they fail to disclose providing a user with information to facilitate the user in determining a location of a cause of a failure within the CAD design and about how to recover from the failure. Accordingly claim 36 is patentable over Burrows in view of Ben-Natan and is in condition for allowance. Claims 37-45 depend from claim 36 and are therefore allowable for at least the same reasons.

Claims 24, 25, 34, 35, 44 and 45

Claims 24, 25, 34, 35, 44 and 45 are rejected under § 103(a) as being unpatentable over Burrows in view of Ben-Natan and Mueller. Claims 24-25, 34-35 and 44-45 depend from claims

16, 26 and 36 respectively. Claims 16, 26 and 36 are allowable over Burrows in view of Ben-Natan for at least the reasons described above. As discussed in the applicant's previous response to office action, Mueller is directed to a method for displaying error messages to a computer programmer to indicate errors in source code that are detected in processing the source code, such as when parsing or compiling the source code. Mueller fails to cure the deficiency of Burrows and Ben-Natan. That is, Mueller fails to disclose receiving a user input to perform an operation on a CAD design and detect a failure during performance of the operation. Further, Mueller does not provide a user with information to facilitate the user in determining a location of a cause of the failure within the CAD design and about how to recover from the failure. Accordingly, base claims 16, 26 and 36 are allowable over Burrows in view of Ben-Natan and Mueller. Dependant claims 25, 25, 34, 35, 44 and 45 are therefore allowable for at least the same reasons.

IV.   Allowable Subject Matter

Claims 51, 57 and 63 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in an independent form. Claims 51, 57 and 63 depend from claims 46, 52 and 58 respectively. For at least the reasons discussed above with respect to the double patenting rejection, the applicant submits that claims 46, 52 and 58 are allowable. Accordingly, claims 51, 57 and 63 are in condition for allowance.

Claims 64-67 are allowed.

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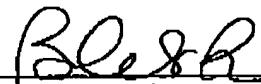
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